

Independent claim 15 has been amended to require that the design material be applied in the form of one of drips, streams, chips and pellets which is described in the specification as originally provided. There is no teaching or suggestion in the '004 Patent for an ability to apply liquid or particulate in such a fashion. Applying a mesh would be done in either sheet or roll form, not as particulates or liquid.

Claims 15 and dependent claim 19 as effected by the amendment to claim are not anticipated by the earlier Weiner patent, namely U.S. Patent No. 6,696,004.

Claim 20 has also been amended to require that the applicator move laterally which would not be thought to occur with a roller which imbeds the mesh in the prior art Weiner '004 reference. Accordingly, claim 20 is believed to be separately allowable on this basis.

#### **Claim Rejections – 35 USC § 103**

The remainder of the claims were rejected as being obvious over Weiner, U.S. Patent No. 6,696,004 either individually or together with a variety of other patents.

Claims 1 and 13 were rejected as being obvious over Weiner ('004).

Weiner ('004) does show imbedding of a mesh. However, as amended, the claimed decorative material is now provided in the form of drips, streams, chips and pellets which could not include a mesh. The imbedding of the mesh in the '004 Patent is also done in a somewhat different manner than the claimed method. Specifically, the mesh was pushed down into vinyl as can be seen in the enclosed prototype samples: one mesh has a square opening and another has round orifices which provided differing aesthetic looks in a different manner than the prototype products produced by the method of the presently amended claims.

If the Examiner will look at the prototype sample with tan and dark brown colorations, the Examiner will observe that there is a texture on this surface. The decorative material was

dripped and/or streamed on a conveyor and then the vinyl applied thereto which is very different than the method which produced the mesh based articles of the prior art patents. Another example is provided showing the deposition of pellet in the vinyl (in this prototype, it was done from above) which can be utilized to create varying effects which also differs from the mesh application of the prior art. Accordingly, as affected by the Amendment, claims 1 and 13 are not believed to be rendered obvious by the prior art mesh based structures.

Claims 1-5, 11-12 and 15-19 are rejected over Weiner in view of Weiner (U.S. Patent No. 6,903,033). In reviewing the '033 and the '004 Patents along with the Office Action, the applicant observes that in the rationale provided in paragraph 5 of the Office Action, it is the first vinyl layer 14 and not the mesh which is used as the decorative material for the obviousness rejection. This is a different rationale than provided above for the anticipation and first set of obviousness rejections where it was the mesh that was the cited decorative material.

It is important to remember that the decorative material as provided in amended claims 1 and 15 do not completely cover a top surface of the conveyor where applied. This is not the case for the first vinyl layer 14 shown in the figures and described in both the '033 and '004 patents. This element is simply not taught or suggested by either of the Weiner references.

There is also no teaching in either of the prior art Weiner references for the statement as provided by claim 4 (and those that depend from claim 4) for depositing a liquid design material onto a conveyor which does not completely cover a top surface of the conveyor. In both the '033 and the '004 Patents, the liquid vinyl layers form continuous surfaces where applied. The limitation cannot be met. These claims are separately allowable on this basis.

Claims 15-19 were rejected as being obvious over Weiner '033. There is no teaching in the prior art Weiner reference for the placing of a design material onto a conveyor which does

not completely cover a top surface of the conveyor where applied and accordingly, these rejections must fall for missing an element since a *prima facie* case of obviousness cannot be established without this element. The mesh is not applied in this manner as acknowledged by the Examiner in the Office Action.

Claims 6-10 were rejected by the prior art Weiner references together with U.S. Patent No. 5,695,696 which shows deposition of vinyl to provide fluorescent borders with a hopper. There does not appear to be any teaching in the above '696 Patent for deposition of design material with a hopper relative to vinyl layers wherein the design material does not completely cover a top surface of the conveyor where applied. The layers where applied in the '696 Patent completely cover the conveyor. Accordingly, as affected by the enclosed amendment, claims 6 and 7 are not rendered obvious by the proposed combination of prior art.

As it relates to claim 8 and claim 9, the applicant finds no support for the rationale provided by the Office Action. While citing the possibility of vibrating hoppers from the prior art, this is believed that this rejection is merely a use of the applicant's specification and providing it in the form of an obviousness rejection using the specification and hindsight. Such a rejection is not believed to be a proper *prima facie* case of obviousness. As it relates to claim 9, and can be seen in enclosed prototype specimens, the lateral movement gives rise to a design which would not be the purpose of a "vibrating hopper" even if one could be found in the prior art. A vibrating hopper in the prior art, if it exists, would likely be utilized to move particulate material and not impart design elements.

The applicant is also having trouble following the rationale for the rejection of claim 10. Specifically, the method of claim 10 requires that a roller having embossed indicia be applied to a liquid design material prior to applying a first vinyl substrate wherein the liquid design material

does not cover a top surface of the conveyor where applied. There is nothing in any of the three cited references teaching this step of the claimed method. This is also not believed to be a proper *prima facie* case of obviousness.

**Specification**

As affected by the enclosed Amendment, claims 1-20 are believed to be allowable and such action is respectfully requested. It is believed that the enclosed prototype samples showing the prior art imbedded mesh structures and the applicant's liquid and solid design material products can be helpful in seeing the differences between the claimed and prior art methods.

Respectfully submitted,

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